



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,764	05/04/2005	William Brown	100884-1P US	6329
22466	7590	10/02/2006	EXAMINER	
ASTRA ZENECA PHARMACEUTICALS LP GLOBAL INTELLECTUAL PROPERTY 1800 CONCORD PIKE WILMINGTON, DE 19850-5437			MOORE, SUSANNA	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/533,764	BROWN ET AL.	
	Examiner	Art Unit	
	Susanna Moore	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10,13,14 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10,13,14,17-21 is/are allowed.
- 6) ☒ Claim(s) 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/8/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's argument, see Remarks/Arguments, filed August 8, 2006, with respect to points 1-4 and 7 have been fully considered and the rejections from the Non-Final Office Action, mailed April 17, 2006 have been withdrawn. Rejections 5 and 6 are still pending.

Claim Rejections - 35 USC § 112

Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Such a utility cannot be deemed enabled.

The scope of the claim includes treating anxiety for which there is no enabling disclosure. Page 12 of the Specification recites, "Compounds of the invention are useful for the treatment of diarrhoea, depression, anxiety, and stress related disorders such as post-traumatic stress disorders, panic disorders, generalized anxiety disorder, social phobia, and obsessive compulsive disorder, ...". The reasons was given in the previous office action.

Applicants traverse this rejection and believe a correlation between anxiety treatment and delta opioid receptors is well established. Applicants continue the argument by noting that delta

Art Unit: 1624

opioid receptor agonists are effective in treating a variety of anxiety but provide no examples of such drugs. The reference provided by Applicants, which was published in 2000, before the filing date of the instant application, by Filliol et. al. (Nature Genetics, 2000, 25, 195-200) provides research data on mice deficient for delta opioid receptors, among other opioid receptors. Using the same quote Applicant provided in their response, “ Therefore, in addition to their potential analgesic activity, δ -agonists may be useful in improving emotional states and, more generally, may be considered in the future as an alternative therapy to alleviate affective disorders.” The term “may” is suggestive of a possibility. It doesn't imply enablement. As was stated in *Ex parte Bhide*, 42 USPQ2d 1441 (1/31/1996), “one skilled in the art would understand the "may be useful" and "may also act as inhibitors" statements to be possibilities -- not actual statements of use.” Therefore, this reference does not provide firm evidence that delta opioid receptor agonists are effective in treating a variety of anxiety.

Allowable Subject Matter

Claims 1-10, 13-14 and 17-21 contain allowable subject matter.

Conclusion

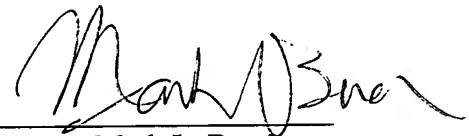
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna Moore whose telephone number is (571) 272-9046. The examiner can normally be reached on M-F 8:00-5:00 pm.

Art Unit: 1624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SM
SM



Mark L. Berch
Primary examiner
Art Unit 1624
Technology Center 1600